

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

AGUINALDO et al.

Application No. 10/820,467

Filed: 03/30/2004

For: *Interferon Variants with Improved Properties*

Examiner: HISSONG, Bruce D.

Art Unit: 1646

Conf. No.: 7268

CERTIFICATE OF ELECTRONIC TRANSMISSION
UNDER 37 C.F.R. 1.6(a)(4)

I hereby certify that this correspondence, including listed enclosures, is being electronically transmitted in Portable Document Form (PDF) through EFS-Web via Hyper Text Transfer Protocol to the United States Patent and Trademark Office on:

Dated: October 2, 2007

Signed: [Signature]
Victoria Poulsen

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181(a)**

Mail Stop Petitions

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit a Petition to Withdraw Holding of Abandonment under 35 CFR 1.181(a). As provided by MPEP 711.03(c)(I), Applicants believe that no fee is due.

Statement of Facts

1. On July 1, 2005, Applicants filed a change of address associated with customer number 32940. The Request for Customer Number Data Change, enclosed herewith as Exhibit A, shows that at least as of July 1, 2005, Applicants were to receive all further correspondence at 555 California Street.

2. In July of 2005, the Applicants filed a change of address with the United States Postal Service.

3. Roughly a year later, presumably sometime in July of 2006, the United States Postal Service discontinued the forwarding of mail to Applicants' new address at 555 California Street, in accordance with Postal Service procedures.

4. On September 15, 2006, the Office mailed an Office Action to Applicants' previous address at Four Embarcadero Center.

5. On September 25, 2006, the Office received the Office Action, which was returned to the Office as undeliverable.

6. On December 1, 2006, attorneys for Applicants moved to a new law firm.

7. On March 16, 2007, the six month statutory period for submitting a response to the Office Action lapsed. Applicants did not submit a response to the Office Action within this period.

8. On March 22, 2007, a Notice of Abandonment was mailed to Applicants' previous address at Four Embarcadero Center.

9. On April 2, 2007, the Office received the Notice of Abandonment, which was returned to the Office as undeliverable.

10. Applicants never received the Office Action mailed September 15, 2006.

11. All Office communications received by Applicants are docketed in Applicants' docketing system.

12. A search of the file jacket and docket records from September 15, 2006, (the date of mailing of the Office Action) to March 22, 2007 (the date of mailing of the Notice of Abandonment) indicates that the Office Action was not received.

13. Exhibit B enclosed herewith shows Applicants' docket record from September 15, 2006, to December 1, 2006 for the present application.

14. Exhibit C enclosed herewith shows Applicants' docket record from December 1, 2006 to March 22, 2007. Because of the change in law firms, Docket No. 28340/US/4 in Exhibit B corresponds to Docket No. 67461-5103 in Exhibit C. In Exhibit C, a query on Attorney Docket No. 67461-5103 would show docket entries for the present case, Application No. 10/820,467. Exhibit C indicates no docket entries during the period spanning December 1, 2006 to March 22, 2007.

15. Exhibit D enclosed herewith shows all of the docket entries for the present application. Entries with respect to the Office Action mailed September 15, 2006, were entered,

as indicated, on June 1, 2007, which was *after* the date of mailing of the Notice of Abandonment on April 2, 2007.

Non-receipt and non-docketing of the Office Action mailed September 15, 2006, is not in dispute.

The file history clearly shows that Applicants did not receive the Office Action mailed September 15, 2006. The United States Postal Service returned to the Office both the original Office Action mailed September 15, 2006, and the original Notice of Abandonment as undeliverable. In addition, Applicants have attached docket records that indicate that those office communications were never received and docketed. Based on the return to the Office of the original office communications as well as the attached docket records, Applicants do not believe that further documentary evidence is necessary to prove non-receipt of the office communication to which reply was required to avoid abandonment. Applicants note that in light of the Office's efforts "to minimize costs and burdens to the practitioner and the Office" in situations such as this, the attached docket record should be deemed sufficient evidence for the present petition. See 1156 OG 53 (October 25, 1993).

The Office has failed to follow proper procedure in notifying Applicants of actions taken by the Office.

Because of the Office's failure to follow its own procedure for notification set forth in the Manual of Patent Examining Procedure as well as Title 37 of the Code of Federal Regulations, the instant application has been improperly held abandoned.

37 CFR 1.32(a)(5)(i) states that "*Customer Number* means a number that may be used to [d]esignate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number[.]" The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. 37 CFR 1.33(a).

Where multiple addresses are associated with an application, the Office must select the address associated with a Customer Number. See 37 CFR 1.33(a) ("If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address."). As the Office will

not recognize more than one correspondence address, 37 CFR 1.33(a), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application will generally be resolved in favor of the address of the Customer Number. MPEP 403(I).

The relocation of Applicants' Representatives resulted in the appearance of more than one correspondence address in the file wrapper of the instant application. The rules require that that such inconsistency be resolved in favor of the address of the Customer Number. The procedure for sending correspondence to the address associated with a Customer Number was not followed in the instant application, resulting in nonreceipt of an Office Action and a subsequent holding of abandonment. The Office's failure to adhere to the procedure provided in the Code of Federal Regulations and the Manual of Patent Examining Procedure has further resulted in a loss of potential patent term.

Application No. 10/820,467 has not been abandoned and the holding of abandonment must be withdrawn.

Although a Notice of Abandonment has been mailed for the instant application, Applicants contend that the application is not in fact abandoned.

35 USC 132(a) requires that "[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof[.]" Failure to prosecute the application within six months of the mailing of an office action results in the application being regarded as abandoned. 35 USC 133. However, the Office is compelled to withdraw the holding of abandonment and to remail any correspondence where Applicants have shown that they have not received the Office communication to which reply is required to avoid abandonment. *See Delgar, Inc. v. Schulyer*, 172 USPQ 513 (D.D.C. 1971); *see also* MPEP 711.03(c)(I).

To establish nonreceipt of an Office communication, the practitioner must state that the Office communication was not received by the practitioner and must attest to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. MPEP 711.03(c)(I)(A). A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *Id.*

As stated above, the Office Action of September 15, 2006, was not received by Applicants. A search of the file jacket and docket records indicates that the Office communication was not received. Applicants have enclosed a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed. *See Exhibits B, C & D.*

Having complied with requirements set forth in *Delgar* and MPEP 711.03(c), Applicants have satisfied the showing required to establish that the Office Action of September 15, 2006, was never received. Applicants therefore request that the Petition to Withdraw the Holding of Abandonment be granted and that the Office remail the outstanding Office Action.

In addition, the Applicants note that any patent issuing from Application No. 10/820,467 is subject to patent term adjustment based on the mistake of the Office. 35 USC 154(b)(1)(A)(ii) provides that if the issue of a patent is delayed due to the failure of the Office to respond to a reply under section 132 within 4 months after the date on which the reply was filed, the term of the patent shall be extended 1 day for each day after such period until the Office has responded. As such, Applicants request that the Patent Term Adjustment calculation include this time period.

The Director is invited to call the undersigned at 415.442.1000. The Director is authorized to charge any additional fees that may be required or to credit any overpayment or refunds to Deposit Account No. 50-0310 (Docket No. 067461-5103-US01).

Respectfully submitted,

Dated: 10/2/07
MORGAN, LEWIS & BOCKIUS LLP
One Market, Spear Street Tower
San Francisco, CA 94105
Telephone: 415.442.1000
Facsimile: 415.442.1001
Customer No. 67374


Robin M. Silva, Reg. No. 38,304

EXHIBIT B

Patent Record Sheet

Docket ID	28340/US/4	Attorneys	SILVA Robin M., NGUYEN Tuan, PARKER AnnEllice, WORRALL Timothy A.
Former ID	SF-A-71431-004/US	Office	San Francisco
Client	Xencor, Inc	Application No	10/820467
Client-Matter	463077-00274	Application Date	Mar-30-2004
Client Ref. No		Grant No	
Country	United States of America	Grant Date	
Short Title	INTERFERON VARIANTS WITH IMPROVED PROPERTIES	1st Publication No	US-2005-0054053-A1
		1st Publication Date	Mar-10-2005
		Expiration Date	
		Priority Date	
Inventors	MUCHHAL Umesh S., MARSHALL Shannon Alicia, AGUINALDO Anna Marie, DESJARLAIS John Rudolf, ZHUKOVSKY Eugene A., BEYNA Amelia Joy, CHO Ho Sung, VILLEGAS* Michael Francis Aquino, QUENSENBERRY Michael Stephen	License of Right	<input type="checkbox"/> Small Entity <input type="checkbox"/>
Convention	Pri. Claimed	Claimed Priorities and Parent Records	
Origin		Relation Docket ID Application No Date Primary	
Type	Patent	Base Provisional 28340/US/1 60/415541 10/1/2002 <input type="checkbox"/>	
Sub Type	Continuation-in-part	Base Continuation- 28340/US/3 10/676705 9/30/2003 <input type="checkbox"/>	
Status	Inactive	Foreign Assoc. & Ref. No.	
Sub Status	Transferred	Tax Receiver	

Docket

Action / Event Notes	Reminder	Due	Done/Recorded
*Awaiting 1st OA		Dec-25-2006	
Response to Restriction Requirement filed 8/25/06; RE-DOCKETED FROM 10/25/06			
Priority Claim Due		Jul-30-2004	Jan-01-1850
6 Mo CIP New Matter Foreign Filing Rem		Sep-30-2004	Jan-01-1850
3 Mo CIP New Matter Foreign Filing Rem		Dec-30-2004	Jan-01-1850
1 Mo CIP New Matter Foreign Filing Rem		Feb-28-2005	Jan-01-1850
CIP Foreign Filing New Matter Deadline		Mar-30-2005	Jan-01-1850
IDS Due		Apr-30-2005	Jan-01-1850
RE-DOCKETED FROM 6/30/2004; NOT NEEDED - ALREADY FILED PER E-MAIL FROM RMS 3/28/2005			
Resp to Restr Requirement Due w/o EOT		Jul-27-2006	Jan-01-1850
Application Date			Mar-30-2004
*Notice of Missing Parts Mail Date (See Notes)			Jul-07-2004
Awaiting Filing Receipt		Jul-30-2004	Jul-07-2004
RE-DOCKETED FROM 6/30/2004			
*Notice of Missing Parts - Response Filed			Nov-05-2004
Publ: First			Mar-10-2005

Patent Record Sheet

*Assignment Recordation Received	May-09-2005
*Restriction Requirement Mailing Date	Jun-27-2006
*Response to Restriction Requirement Filed	Aug-25-2006

Memo:

***Files have been transferred on 12/12/06 to:
Robin Silva, Esq.
Morgan, Lewis & Bockius LLP
One Market, Spear Street Tower
San Francisco, CA 94105***

Report Selection

Record Count: 0

- ☒ by Docket Number
☐ by Country
☐ by Client
☐ by Owner
☐ by Inventor

Preview before printing ☒

Report Format

☐ Concise
☒ Comprehensive

Inventors

☐ Print
☒ Do Not Print

Remarks

☒ Print
☐ Do Not Print

Images/Links

☐ Print
☒ Do Not Print

Include Design Countries

☐ Print
☒ Do Not Print

Date Range

☒ Filing
☐ Issue
☐ Expiration
☐ Last Update

From: 01-Dec-2006

To: 22-Mar-2007

Docket Number: 67461-5103

Client:

Agent:

Country:

US

United States of America

Area:

Attorney:

Inventor:

Owner:

Location:

Status(es):

Status Codes:

☐ Active
☐ Inactive
☒ All

Case Type(s):

EXHIBIT C

EXHIBIT D

Actions Due

Thursday, September 27, 2007

Page: 1

Docket Number: 67461-5103

SubCase: 01

Ctry Sub:

Country: US United States of America

Case Type: CIP

Status : Abandoned

Filing Date: 30-Mar-2004

Action Type: PA/3OA

Base Date: 15-Sep-2006

Application # : 10/820,467

Response sent date:

Action(s) Due	Due Date	Indicator	Taken
Reply to OA - 1 Month	15-Nov-2006	Reminder	01-Jan-1850
Reply to OA	15-Dec-2006	Due Date	01-Jan-1850
Reply to OA + 1 Month EOT	15-Jan-2007	Due Date	01-Jan-1850
Reply to OA + 2 Month EOT	15-Feb-2007	Due Date	01-Jan-1850
Reply to OA + 3 Month EOT	15-Mar-2007	Final	01-Jan-1850

Remarks:

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Date Created: 01-Jun-2007

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